REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed October 1, 2007. Applicant has amended claims 1-5, 13-15 and 37 to clarify the invention. The Applicant traverses the rejections to claims 1-39. Reconsideration and allowance of the subject application and presently pending claims 1-39 is respectfully requested.

I. Response to Claim Rejections Based on Enablement

Claims 8 and 9 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim subject matter which Applicant regards as the invention. Specifically, the Examiner states, "it is not possible to know how the dimensions of a particular patient or radiographic data therefrom structurally limit the bone graph of claim 1." The rejection is in error because claims 8 and 9 are sufficiently enabled by the specification.

Applicant specifies, "The graft may be manufactured to standard dimensions or it may be manufactured to patient-unique dimensions which may be determined radiographically prior to surgery and prior to manufacturing of the bone graft" and continues, "The bone graft may have composition and/or local geometry that varies from one place to another, and may have a particular composition and/or local geometry at places intended to adjoin natural bone." Paragraph [0013]. The dimensions of bone in a patient or radiographic data from a patient, which is used to determine dimension of bone, are needed to determine the most appropriate graft. The graft would be deemed appropriate based on its shape or dimension. Just as the

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size and shape of a shoe is chosen based on the particular dimensions of a foot, the shape or dimensions of a bone graft is chosen based on a particular dimensions of a patient's bone.

The Applicant supports enablement of claims 8 and 9 through examples. In paragraph [0063] it is stated "the implant base template may take its overall location from one or more teeth or other features in the patient's mouth." Next, the Applicant states, "In some instances...the bone graft is manufactured to fit with radiographically determined bone dimensions..." Paragraph [0056]. Lastly, the Applicant states, "In regard to designing the bone graft uniquely for a particular patient, such as from radiographic data, appropriate techniques are described in co-pending commonly assigned U.S. patent applications Ser. No. 09/828,504 and Ser. No. 09/972,832" thereby implying that the shape or dimension of a bone graft being based on dimensions of bone in a particular patient or on radiographic data from a particular patient is a commonly understood relationship within the field.

Based on the passages specified herein the Applicant believes that claims 8 and 9 are sufficiently enabled. Withdrawal of the rejection is respectfully requested.

II. Response to Claim Rejections Based on Subject Matter

In the Office Action, claims 3-5 are rejected under 35 U.S.C. 101 as being non-statutory subject matter. Claims 3-5 have been amended to better clarify that a human is not within the scope of the claims. Applicant respectfully submits that the term "alveolar ridge" in claims 3-5 is present to provide a structural limitation to the claims and not to include a human, or part thereof, in the scope.

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III. Response to Claim Rejections based on Anticipation

In the Office Action, claims 1-14, 17, 18, 20, 24, 25, 27-31, 33, 35 and 36 are rejected as being anticipated by US Patent 5,972,368 to McKay. For a proper rejection of a claim under 35 USC§102(b), the cited reference must disclose all elements/features/steps of the claim. See, *e.g.*, E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co., 849 F.2d 1430, 7 USPQ2d 1129 (Fed. Cir. 1988).

Claims 1 and 37 require, "an at least partially alveolar ridge-shaped graft." Neither McKay, nor Khandkar et al, nor Anderson disclose an at least partially alveolar ridge-shaped graft. As discussed in the background, alveolar ridge augmentations have previously been accomplished through multiple procedures using a formable filler material intended to become bone that are subject to possible resorption and the transmission of disease. There is no evidence in the prior art, cited or otherwise, to produce the at least partially alveolar ridge-shaped graft disclosed in the present invention as required by claims 1 and 37. Thus, claims 1 and 37 cannot be anticipated by the prior art.

Claims 2-36 and 38-39 depend from claim 1 and 37 and are allowable for at least the reason that they depend from an allowable claim.

IV. Response To Claim Rejections Based On Obviousness

In the Office Action, claims 15, 16, 32, 34 and 39 are rejected as obvious over McKay or US Publication No. 2003/0009225 to Khandkar in view McKay. It is well established at law that, for a proper rejection of a claim under 35 U.S.C. §103 as

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being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest, either implicitly or explicitly, all elements/features/steps of the claim at issue. See, e.g., In re Dow Chemical, 5 U.S.P.Q. 2d 1529, 1531 (Fed. Cir. 1988), and In re Keller, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981).

Claims 1 and 37 require, "an at least partially alveolar ridge-shaped graft." Neither McKay nor Khandkar et al disclose an at least partially alveolar ridge-shaped graft. As discussed in the background, alveolar ridge augmentations have previously been accomplished through multiple procedures using a formable filler material intended to become bone that are subject to possible resorption and the transmission of disease. There is no evidence in the prior art, cited or otherwise, to produce the at least partially alveolar ridge-shaped graft disclosed in the present invention as required by claims 1 and 37. Thus, the cited references fail to disclose every element of the claimed invention. Claims 15, 16, 32, 34 and 39 are allowable at least for the reason they depend from claims that contain elements not disclosed in the cited references.

V. Double Patenting

The Applicant submits the claims herein are sufficiently narrow to void the double patenting rejection.

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CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and rejections have been traversed, rendered moot and/or accommodated, and that presently pending claims 1-39 are in condition for allowance. Favorable reconsideration and allowance of the present application and the presently pending claims are hereby courteously requested. If in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (603) 668-1400.

Respectfully submitted,

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CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this correspondence is being deposited with the United States Patent Office via the electronic filing procedure on March 31, 2008.

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